

REMARKS

Applicants have herein amended claim 11 to delete reference to "95% identical" and to cancel part (j), without prejudice or disclaimer. Applicants have also canceled claims 32-37 and 43-47, without prejudice or disclaimer. Applicants reserve the right to pursue subject matter encompassed by all canceled claims in one or more continuation applications.

Claims 11, 26-31 and 38-42 are currently pending. No new matter has been added.

I. Provisional Election and Restriction Requirement with Traverse

The Examiner has required an additional election under 35 U.S.C. § 121 to one of eleven groups. The Examiner contends that the individual groupings encompass patentably distinct inventions.

The Examiner has indicated that "Applicants newly filed claims are drawn to numerous [11] patentably distinct amino acid sequences. Thus, further restriction *within* the formerly presented Invention IV is required under 35 U.S.C. 121...". See, Paper No. 20050804, pages 2-3, section 2 (emphasis in original). The Examiner also indicated: "Applicants should note that in some cases multiple claims encompass one of the patentably distinct inventions set forth herein. To be fully responsive to this requirement, Applicants are **required** to point out which claims correspond to the elected invention." See, Paper No. 20050804, pages 3, section 3 (emphasis in original).

In the presently pending Office Action, the Examiner has further restricted claims 11 and 26-47 into eleven different groups. In order to fully comply with this second restriction requirement, Applicants hereby provisionally elect, *with traverse*, Group IV-K drawn to polypeptides comprising "amino acid residues 1(2)-425 of SEQ ID NO:2." See, Paper No. 20050804, page 3, first sentence.

In respect of the requirement to point out which claims correspond to the elected invention, Applicants respectfully request clarification of the meaning of the term "correspond to the elected invention". Without such clarification Applicants are uncertain about the scope of the claimed subject matter which the Examiner is willing to examine. The lack of clarity on this issue is also compounded because the Examiner has not

indicated which claims belong to which group as required by M.P.E.P. § 816, 4th paragraph, 1st sentence and § 817 "Outline of Letter", part (A)(2).

In order to be fully compliant with the presently pending office action, Applicants note that presently pending claims 11, 26-31 and 38-42 are each considered to correspond to the elected invention as each of these claims comprise subject matter encompassed by provisionally elected Group IV-K (*i.e.*, comprising amino acid residues 1(2)-425 of SEQ ID NO:2). Moreover, if necessary to further insure compliance with the pending restriction requirement, Applicants provisionally elect, *with traverse*, claim 38 (and claims 39-42 which are dependent thereon) for the reasons explained below.

Applicants note that the presently pending claims contain generic claims linking species claims. In this regard the MPEP states:

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible.

The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

(A) genus claims linking species claims;

(B) a claim to the necessary process of making a product linking proper process and product claims;

(C) a claim to "means" for practicing a process linking proper apparatus and process claims; and

(D) a claim to the product linking a process of making and a use (process of using).

Where linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered to be linking. Examiners should use Form Paragraph 8.12 to make restrictions involving linking claims.

See, MPEP § 809.03 (emphasis added).

In this regard, Applicants respectfully submit that in the present case there exist genus claims that link species claims. Moreover, the MPEP defines a generic claim as follows (in pertinent part):

In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof. When all or some of the claims directed to one of the species in addition to the elected species do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species. See MPEP Section 809.02(c).

See, MPEP § 806.04 (emphasis added).

As such, claim 38 is a generic linking claim for claims 26 and 27. Likewise, claim 27 is a generic linking claim for claim 26. This is because, in accordance with the above recited MPEP guidelines, the generic claim (for example, claim 38) includes no material element additional to those recited in the species claims (*i.e.*, claims 26 and 27) and comprehends within its confines the organization covered in each of the species.

Once a generic linking claim is properly identified, the MPEP §809 states, in part, that:

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP Section 809.03 for definition of linking claims.

The linking claims *must* be examined with the invention elected, and *should any linking claim be allowed, the restriction requirement must be withdrawn.* Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which *depends from or includes all the limitations of the allowable linking claim must be rejoined* and will be fully examined for patentability. Where such

withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability.

(Emphasis added).

Therefore, the MPEP requires examination of generic linking claims with the invention elected. Should any linking claim be *allowed*, the restriction requirement *must* be *withdrawn*, and any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim *must be rejoined* and will be fully examined for patentability. Therefore, pursuant to MPEP §§ 806.04 and 809, the generic linking claims (*e.g.*, claim 38) should be examined with the invention elected.

Thus, Applicants respectfully request that the Examiner withdraw the present restriction requirement and, *at least*, examine the generic linking claims for patentability. Further, upon indication of the allowability of the generic linking claims, Applicants respectfully request that the Examiner rejoin all the linked inventions that contain the limitations recited within the allowed generic claims.

With respect to the Markush group in claim 11, Applicants note that the M.P.E.P. instructs:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

See, M.P.E.P. § 803.02 (Restriction — Markush Claims).

In this regard, Applicants respectfully submit that the members of the Markush group in amended claim 11, *even if not considered sufficiently few in number, are* so closely related (because each is a part of SEQ ID NO:2) that a search and examination of the entire claim can be made without serious burden.

Furthermore, Applicants submit that the amendments to claim 11 and cancellation of claims 32-37 and 43-47 made herein have further reduced the Examiner's burden in examining the presently claimed subject matter.

Hence, Applicants respectfully submit that it would not impose a serious burden to examine pending claims 11, 26-31 and 38-42. Therefore, Applicants request that the second restriction requirement be reconsidered and withdrawn, and that pending claims 11, 26-31 and 38-42 be examined.

In the event that, after consideration of the instant response, the Examiner intends to make the instant restriction requirement final without modification, Applicants respectfully request an interview with the Examiner and his supervisor prior to the issuance of the next Office Action. The Examiner should feel free to contact the undersigned below to discuss the matter. Applicants submit that should the restriction requirement be made final, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

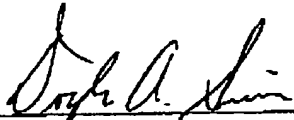
Conclusion

Applicants respectfully request that the above remarks be made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required

for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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